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| APPLICATION NO.                                                            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/508,828                                                                 | 11/09/2004  | Koichi Nishimura     | 2593-0148PUS1       | 3768             |
| 2292                                                                       | 7590        | 11/01/2006           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | SHAHER, RICKY D     |                  |
|                                                                            |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                            |             |                      | 2872                |                  |

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                          |  |
|------------------------------|--------------------------------------|------------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/508,828 | <b>Applicant(s)</b><br>NISHIMURA, KOICHI |  |
|                              | <b>Examiner</b><br>Ricky D. Shafer   | <b>Art Unit</b><br>2872                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08/07/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Applicant's renewed traversal on the basis that there was no lack of unity performed in the International PCT Application and thus, prevents the examiner from requiring a lack of unity in a U.S. National Stage Application, based on the International PCT Application. This is not found persuasive because MPEP 1893.03(d) clearly states that the examiner may restrict provided that there exist no common or corresponding special technical feature which defines a contribution, makes allowable, over the prior art. In this particular case, the feature common to both Groups I and Group II is "a thermoplastic resin film extruded by an extruding machine" which is well known in the art and does not define an allowable contribution over the prior art. Thus, if any special technical feature is present, it must relate to the separate features of the particular invention (i.e., the particular retardation details of Group I or the particular cooling and rotational speed details of Group II).

Accordingly, the requirement is still deemed proper and is therefore again made FINAL.

2. Applicant's arguments filed 08/07/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., some undefined, theoretical Z value) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6-7, the language “each point... $10^{-5}$ ” is vague and indefinite due to the fact it is unclear to the examiner whether the formula recited by applicant is referring to some retardation value of the film or to some other characteristic not positively recited or clearly defined by the claim. Thus, the metes and bounds of the claim is unclear and indefinite.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahiko ('221).

To the extent the claims are definite, Takahiko discloses an optical film composed of a thermoplastic resin film having an alicyclic structure (see paragraphs 006 and 007) obtained by using a melt extruding machine (see paragraphs 0016-0017), characterized in that said thermoplastic resin film satisfies a relation of the formula recited by applicant over the whole surface of the film (see paragraphs 004, 006, 0012 and examples 1-4 in paragraph 0024) when an angle made by the extruding direction of the thermoplastic resin film from the melt extruding machine and a slow phase axis at each point is  $\alpha$ , and a retardation amount at each point is  $R_e$ , wherein  $R_e$  is 10 nm or less (see paragraph 0024) and wherein the optical film is a protective

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film of a polarizer and the protective film is provided on one surface or both surfaces of the polarizer (see paragraph 0013) via an adhesive layer (see paragraph 0023) and wherein the optical film provides for a phase difference obtained by performing a stretch processing on the optical film (see paragraphs 0008-0011 and examples 1-4 in paragraph 0024), wherein the examiner is considering the  $R_e$  value to be less than  $3.4 \times 10^{-5}$ , in particular less than 10 nm.

7. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

In addition, the drawings must show every feature of the invention specified in the claims. Therefore, the thermoplastic resin film, the melt extruding machine, the first, second and third cooling drum, the polarizer, the protective film and the adhesive layer must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. Claims 11 and 12 are objected to because of the following informalities:

In claim 11, line 1 and 12, line 2, the language "froth" should be changed to read --forth--.

Appropriate correction is required.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320.

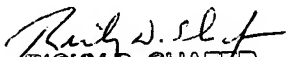
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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

October 27, 2006

  
RICKY D. SHAFFER  
PATENT EXAMINER  
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